



Patent Docket No. P1543R1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--|--|
| In re Application of Anthony H. Dodge et al. Serial No.: 09/449,204 Filed: November 24, 1999 For: PCR ASSAY | Group Art Unit: 1643 Examiner: not assigned |
| <p style="text-align: center;">CERTIFICATE OF MAILING I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Box MISSING PARTS, Assistant Commissioner for Patents, Washington, DC 20231, Attn Application Division, Special Filings Unit on</p> <p style="text-align: right;">March 24, 2000</p> <p style="text-align: right;">Tara E. Faenza</p> | |

RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION

BOX MISSING PARTS
Assistant Commissioner for Patents
Washington, DC 20231

Sir/Madam:

Responsive to the *Notice to File Missing Parts - Filing Date Granted* dated December 27, 1999, enclosed herewith are the following documents:

1. Combination Declaration and Power of Attorney duly executed by five inventors;
2. Combination Declaration and Power of Attorney duly executed by one inventor;
3. *Notice to File Missing Parts - Filing Date Granted* (Form PTO-1533 - Part 2).

The Commissioner is hereby authorized to deduct the appropriate surcharge fee of \$130 associated with this communication or credit any overpayment to Deposit Account No. 07-0630 (our Ref. P1543R1). A duplicate of this sheet is enclosed.

Respectfully submitted,

GENENTECH, INC.

Date: March 24, 2000
By:
Timothy R. Schwartz, Ph.D.
Reg. No. 32,171

1 DNA Way
South San Francisco, CA 94080-4990
Phone: (650) 225-7467
Fax: (650) 952-9881

Revised (10/18/95)

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | |
|--------------------|---------------------|-----------------------|--------------------------|
| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO/TITLE |
| 09/449, 204 | 11/24/99 | SINICROPI | D P1543R1 |

0262/1227

NOT ASSIGNED

TIMOTHY R SCHWARTZ PH D
GENENTECH INC
1 DNA WAY
SOUTH SAN FRANCISCO CA 94080-4990

49

1643

DATE MAILED:

12/27/99

NOTICE TO FILE MISSING PARTS OF APPLICATION

Filing Date Granted

All Application Number and Filing Date have been assigned to this application. The items indicated below, however, are missing. Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). If any of items 1 or 3 through 5 are indicated as missing, the SURCHARGE set forth in 37 CFR 1.16(e) of \$65.00 for a small entity in compliance with 37 CFR 1.27, or \$130.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.

If all required items on this form are filed within the period set above, the total amount owed by applicant as a
 small entity (statement filed) non-small entity is \$ 150.

1. The statutory basic filing fee is:

missing.
 insufficient.

Applicant must submit \$ 150 to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).

2. The following additional claims fees are due:

\$ 150 for total claims over 20.

\$ 150 for independent claims over 3.

\$ 150 for multiple dependent claim surcharge.

27 FEB 2000

Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.

3. The oath or declaration:

is missing or unsigned.

does not cover the newly submitted items.

An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date is required.

4. The signature(s) to the oath or declaration is/are by a person other than inventor or person qualified under 37 CFR 1.42, 1.43 or 1.47.

A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

5. The signature of the following joint inventor(s) is missing from the oath or declaration:

An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

6. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21(m)).

7. Your filing receipt was mailed in error because your check was returned without payment.

8. The application was filed in a language other than English.

Applicant must file a verified English translation of the application, the \$130.00 set forth in 37 CFR 1.17(k), unless previously submitted, and a statement that the translation is accurate (37 CFR 1.52(d)).

9. OTHER:

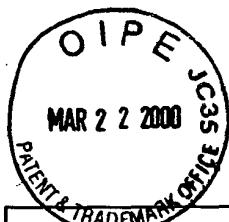
Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

Washington A copy of this notice **MUST** be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202

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09/449204
09/44930
09/44935
11/2000 MBERNE 00000035
C:105 130.00 CH
U.S. GPO 165-456-6675



Patent Docket P1543R1

Section 11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|--|
| In re Application of Anthony H. Dodge et al. Serial No.: 09/449,204 Filed: November 24, 1999 For: PCR Assay | Group Art Unit: 1643 Examiner: not assigned |
| <p style="text-align: center;">CERTIFICATE OF MAILING I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on March 24, 2000</p> <p style="text-align: right;">_____ Tara E. Faenza</p> | |

TRANSMITTAL LETTER

BOX MISSING PARTS
Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

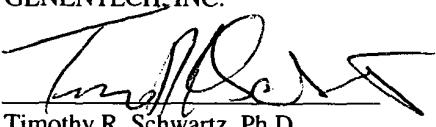
Transmitted herewith are the following documents:

1. Response to Notice to File Missing Parts and copy of same, including:
 - a. Combined Declaration and Power of Attorney duly executed by five inventors;
 - b. Combined Declaration and Power of Attorney duly executed by one inventor;
 - c. *Notice to File Missing Parts - Filing Date Granted* (Form PTO-1533 - Part 2);
 - d. Authorization to charge \$130.00 surcharge to deposit account.
2. Petition for One Month Extension of Time and copy of same including:
 - a. Authorization to charge \$110.00 fee to deposit account.
3. Postage pre-paid return postcard.

In the event any additional fees are due in connection with the filing of these documents, the Commissioner is authorized to charge such fees to our Deposit Account No. 07-0630 (our ref. P1543R1).

Respectfully submitted,

GENENTECH, INC.

Date: March 24, 2000
By: 
Timothy R. Schwartz, Ph.D.
Reg. No. 32,171

1 DNA Way
So. San Francisco, CA 94080-4990
Phone: (650) 225-7467
Fax: (650) 952-9881

BEST AVAILABLE COPY



**COMBINED DECLARATION FOR PATENT APPLICATION
AND POWER OF ATTORNEY**

Docket No. P1543R1

As a below named Inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

PCR Assay

the specification of which (check one) is attached hereto or was filed on November 24, 1999 as Application Serial No. 09/449,204 and was amended on (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate have a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s):

| <u>Priority Claimed</u> |
|-------------------------|
| <u>Yes</u> |
| <u>No</u> |

| Number | Country | Day/Month/Year Filed |
|--------|---------|----------------------|
|--------|---------|----------------------|

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional applications(s) listed below:

| | |
|----------------------|-------------------|
| 60/110,259 | November 30, 1998 |
| Application Ser. No. | Filing Date |

I hereby claim the benefit under Title 35, United States Code, §120 of any United States applications(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

| | | |
|----------------------|-------------|--------------------------------------|
| Application Ser. No. | Filing Date | Status: Patented, Pending, Abandoned |
|----------------------|-------------|--------------------------------------|

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Elizabeth M. Barnes - Reg. No. 35,059

Mark T. Kresnak - Reg. No. 42,767

Walter E. Buting - Reg. No. 23,092

Wendy M. Lee - Reg. No. 40,378

Deirdre L. Conley - Reg. No. 36,487

Richard B. Love - Reg. No. 34,659

Janet E. Hasak - Reg. No. 28,616

Timothy R. Schwartz - Reg. No. 32,171

Sean A. Johnston - Reg. No. 35,910

Craig G. Svoboda - Reg. No. 39,044

Dennis G. Kleid - Reg. No. 32,037

Lee K. Tan - Reg. No. 39,447

Jeffrey S. Kubinec - Reg. No. 36,575

Send correspondence to Genentech, Inc.

Attn: Timothy R. Schwartz, Ph.D.

1 DNA Way

South San Francisco, CA 94080-4990

Telephone: (650) 225-7467

I hereby declare that all statements made herein of my own knowledge and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issued thereon.

The undersigned hereby authorizes the U.S. attorney or agent named herein to accept and follow instructions from his foreign patent agent as to any action to be taken in the Patent and Trademark Office regarding this application without direct communication between the U.S. attorney or agent and the undersigned. In the event of a change in the persons from whom instructions may be taken, the U.S. attorney or agent named herein will be so notified by the undersigned.

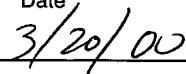
Full name of sole or first inventor

Anthony H. Dodge

Inventor's signature



Date



Residence

1542 Kalmia Street, San Mateo, California 94403

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of second joint inventor, if any

Yu-Ju G. Meng

Inventor's signature

Date

Residence

1033 Ventura Avenue, Albany, California 94706

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of third joint inventor, if any

Paul W. Sims

Inventor's signature

Date

Residence

377 Laurie Meadows Drive #327, San Mateo, California 94403

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Telephone: (650) 225-7467

I hereby declare that all statements made herein of my own knowledge and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issued thereon.

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Full name of sole or first inventor

Anthony H. Dodge

Inventor's signature

Date

Residence

1542 Kalmia Street, San Mateo, California 94403

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of second joint inventor, if any

Yu-Ju G. Meng

Inventor's signature

Date

3-17-00

Residence

1033 Ventura Avenue, Albany, California 94706

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of third joint inventor, if any

Paul W. Sims

Inventor's signature

Date

3-17-00

Residence

377 Laurie Meadows Drive #327, San Mateo, California 94403

Citizenship

United States

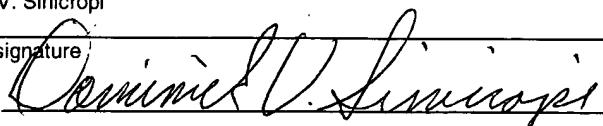
Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of fourth joint inventor, if any

Dominick V. Sinicropi

Inventor's signature



Date

3-17-00

Residence

246 San Clemente Drive, Menlo Park, California 94025

Citizenship

United States

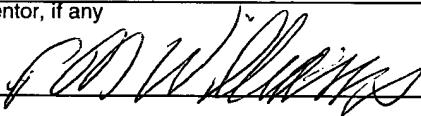
Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of fifth joint inventor, if any

P. Mickey Williams

Inventor's signature



3/17/2000

Date

Residence

509 Alto Avenue, Half Moon Bay, California 94019

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of sixth joint inventor, if any

Wai Lee Wong

Inventor's signature



March 17, 2000.

Date

Residence

26333 Aric Lane, Los Altos Hills, California 94022

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080



**COMBINED DECLARATION FOR PATENT APPLICATION
AND POWER OF ATTORNEY**

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PCR Assay

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Prior Foreign Application(s):

| Priority Claimed | |
|------------------|----|
| Yes | No |

| Number | Country | Day/Month/Year Filed |
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| Application Ser. No. | Filing Date | Status: Patented, Pending, Abandoned |
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POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

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Mark T. Kresnak - Reg. No. 42,767

Walter E. Buting - Reg. No. 23,092

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Janet E. Hasak - Reg. No. 28,616

Timothy R. Schwartz - Reg. No. 32,171

Sean A. Johnston - Reg. No. 35,910

Craig G. Svoboda - Reg. No. 39,044

Dennis G. Kleid - Reg. No. 32,037

Lee K. Tan - Reg. No. 39,447

Jeffrey S. Kubinec - Reg. No. 36,575

Send correspondence to Genentech, Inc.

Attn: Timothy R. Schwartz, Ph.D.

1 DNA Way

South San Francisco, CA 94080-4990

Full name of fourth joint inventor, if any

Dominick V. Sinicropi

Inventor's signature

Date

Residence

246 San Clemente Drive, Menlo Park, California 94025

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of fifth joint inventor, if any

P. Mickey Williams

Inventor's signature

Date

Residence

509 Alto Avenue, Half Moon Bay, California 94019

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080

Full name of sixth joint inventor, if any

Wai Lee Wong

Inventor's signature

Date

Residence

26333 Aric Lane, Los Altos Hills, California 94022

Citizenship

United States

Post Office Address

1 DNA Way
South San Francisco, CA 94080